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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Dayton, Ohio

Docket No. 8243.00

Application of

John G. Savage et al.

MAR 24 2005

Serial No. 09/433,135

Group Art Unit: 3629

Filed: November 3, 1999

Examiner: Dennis W. Ruhl

For: SELF-SERVICE TERMINAL

CERTIFICATE OF MAILING

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APPEAL BRIEF

Sir:

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on **February 2, 2005**. Three copies of the Appeal Brief are filed herewith. Authorization is given to charge deposit account number 14-0225 for the fee under 37 C.F.R. 1.17 for filing the Appeal Brief.

(1) REAL PARTY IN INTEREST

The present application is assigned to NCR Corporation of Maryland.

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF ALL CLAIMS

The above-identified patent application was filed on November 3, 1999 with claims 1-35. In response to an Office Action mailed on April 24, 2002, no claims were canceled. In response to a final Office Action mailed on July 25, 2002, no claims were canceled. In response to an Office Action mailed on April 10, 2003, claims 22-24, 29, 30, 34, and 35 were canceled, and claims 25-28 and 31-33 were canceled and new claims 36-42 were added in their place. In response to an Office Action mailed on April 15, 2004, claims 1-21 and 36-42 were canceled, and new claims 43-52 were added. In response to a final Office Action mailed on October 25, 2004, no claims were canceled. In response to an Advisory Office Action mailed on December 21, 2004, a Notice of Appeal was filed on February 2, 2005. Thus, claims 43-52 stand rejected.

Claims 43-52 are being appealed and are attached as an appendix to this Appeal Brief.

(4) STATUS OF ALL AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

The Amendment of December 3, 2004 which responded to the final Office Action of October 25, 2004 was entered to overcome rejection under 35 U.S.C. §112, first paragraph.

(5) CONCISE SUMMARY OF THE INVENTION

A self-service terminal, such as an automated teller machine (ATM) 10, allows a user of the terminal to conduct an item dispensing transaction using spoken words (see page 4, lines 4-5 and 9-11; page 5, lines 11-15; and page 6, lines 25-26 of the specification). The terminal creates at least one audible item dispensing prompt which contains within the prompt itself at least one word which is provided by the terminal and which can be spoken by the user to instruct the terminal to dispense an item to the user (see page 5, lines 15-20). The terminal delivers the at least one audible prompt to the user (see page 5, lines 15-20). The terminal receives at least one word spoken by the user after the at least one audible prompt is delivered to the user (see page 5, lines 15-20). The terminal then determines if the at least one word

received from the user corresponds to the at least one word provided by the terminal (see page 5, lines 15-20). An item is dispensed to the user when the at least one word received from the user corresponds to the at least one word provided by the terminal (see page 4, lines 4-5, 9-11, and 26-27; and page 6, lines 25-26).

The prompt itself may comprise a question which can be answered by the user speaking either a positive response or a negative response to the question (see page 2, lines 21-23). If this is the case, then an item is dispensed to the user when the at least one word received from the user answers the question by indicating that the user chooses to have an item dispensed (see page 2, lines 21-23).

(6) THE REJECTION

Claims 43, 44, and 46-49 are rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,081,782 to Rabin (referred to herein as “Rabin”).

Claim 45 is rejected under 35 U.S.C. §103(a) as being unpatentable over Rabin in view of U.S. Patent No. 4,420,751 to Paganini et al. (referred to herein as “Paganini”).

Claims 50-52 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rabin.

(7) GROUPING OF CLAIMS FOR EACH GROUND OF REJECTION WHICH APPLICANT CONTEST

Claims 43-49 are grouped together.

Claims 50 and 52 are grouped separately.

Claim 51 is grouped separately.

(8) CONCISE STATEMENT OF ALL ISSUES PRESENTED FOR REVIEW

An issue presented for review is whether each of claims 43-49 is patentable over Rabin.

Another issue presented for review is whether each of claims 50 and 52 is patentable over Rabin.

Another issue presented for review is whether claim 51 is patentable over Rabin.

(9) APPLICANT'S POSITION

Claims 43-49

Each of claims 43, 44, and 45 recites, inter alia:

“means for creating at least one audible item dispensing prompt which contains within the prompt itself at least one word which is provided by the terminal and which can be spoken by the user to instruct the terminal to dispense an item to the user”.

Each of claims 46 and 47 recites, inter alia:

“means for creating at least one audible item dispensing prompt which contains within the prompt itself a question which can be answered by the user speaking either a positive response or a negative response to the question”.

Each of claims 48 and 49 recites, inter alia:

“means for creating an audible cash dispensing prompt which contains within the prompt itself a cash dispensing word which is provided by the ATM and which can be spoken by the customer to instruct the ATM to dispense cash to the customer”.

With regard to claims 43-49, Applicant notes that the Examiner has not addressed the above specific language recited in each claim. In fact, the Examiner states the following in the Advisory Action of December 21, 2004 in connection with claims 43-49:

“....In the article claims all that is recited is a means to create a prompt, where the prompt itself is taken as non-functional descriptive material and does not serve to further distinguish the invention in terms of structure. The particular prompt that the ATM states and the user speaks is not given patentable weight in the article claims, only the method claims, because only structure is looked at in article claims, not the intended manner of use....”.

Thus, the rejection of each of claims 43-49 is improper and, therefore, should be withdrawn.

Claims 50 and 52

Claim 50 recites, inter alia:

"creating at least one audible item dispensing prompt which contains within the prompt itself at least one word which is provided by the terminal and which can be spoken by the user to instruct the terminal to dispense an item to the user".

Claim 52 recites, inter alia:

"creating at least one audible cash dispensing prompt which contains within the prompt itself at least one word which is provided by the ATM and which can be spoken by the customer to instruct the ATM to dispense cash to the customer".

With regard to claims 50 and 52, Applicant notes that the Examiner merely states "It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the terminal of Rabin with the ability to "help" the customer with their transaction by informing them of their possible choices.....Having the terminal "help" the customer by informing them of their possible transaction options is considered obvious". However, Applicant would like to respectfully point out that the Examiner has cited no references and has only made a broad conclusory statement to justify making the rejection.

Applicant would also like to respectfully point out that if the purpose to be achieved was simply to "help" a customer, then Rabin would be modified to say some general statement such as "you may request cash, check your balance, or pay bills at this ATM". This would allow the ATM to wait for the pre-registered word to be uttered by the customer. Using pre-registered word assignments is core to the invention of Rabin. Note that Rabin "stores for each authorized user, one or a series of speech models of voice commands or phrases uttered by the authorized user" (see column 2, lines 16-19 of Rabin). Rabin uses voice as a command and verification system. The pre-registered words used in Rabin have an associated "action component which specifies the specific action that the authorized user desires in response to the issuance of the corresponding voice command" (see column 2, lines 20-23 of Rabin). It is the intention of Rabin to allow different users to use different words for implementing the same transactions.

Even arguendo if Rabin wanted to be more helpful (as the Examiner suggests in the Office Action of October 24, 2004), it would do so by using a generic statement to guide the customer, without actually providing the customer with a prompt "which contains within the prompt itself at least one word which is provided by the terminal and which can be spoken by the user to instruct the terminal to dispense an item to the user". Thus, Rabin teaches away from the presently claimed invention (i.e., providing the customer with a word to use in a transaction instruction).

Furthermore, Applicant notes that the Examiner specifically acknowledges in the final Office Action of October 24, 2004 that "...Rabin does not disclose that the spoken prompt from the terminal is the same word that is spoken by the user to cause an action to be done". Thus, the rejection of each of claims 50 and 52 under 35 U.S.C. §103(a) is improper by the Examiner's own admission.

Claim 51

Claim 51 recites, inter alia:

"creating at least one audible item dispensing prompt which contains within the prompt itself a question which can be answered by the user speaking either a positive response or a negative response to the question".

With regard to claim 51, Applicant notes that the Examiner merely states "It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the terminal of Rabin with the ability to "help" the customer with their transaction by asking them what they want to do.....It is very old and well known that one question that is asked by ATM machines is "Would you like to perform another transaction". Having the terminal ask this question is considered obvious". However, Applicant would like to respectfully point out that the Examiner has cited no references and has only made a broad conclusory statement to justify making the rejection.

Furthermore, the above example provided by the Examiner does not meet the claim limitations of claim 51 because the example does not relate to an item dispensing prompt that contains "...within the prompt itself a question which can be answered by the user speaking

either a positive response or a negative response to the question" as recited in claim 51 of the present application. In particular, the example given by the Examiner merely asks if the ATM user would like to perform another transaction. This is not the same as asking if the user wishes to instruct an item dispensing operation. Thus, the rejection claims 51 under 35 U.S.C. §103(a) is improper and, therefore, should be withdrawn.

(10) CONCLUSION

In view of the forgoing reasons, it is clear that the rejection of claims 43, 44, and 46-49 under 35 U.S.C. Section 102(e) is improper and, therefore, should be withdrawn. Also, it is clear that the rejection of claims 45 and 50-52 under 35 U.S.C. Section 103(a) is improper and, therefore, should be withdrawn. Accordingly, it is respectfully requested that the Board reverse the rejection of claims 43-52.

Respectfully submitted,



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(11) APPENDIX

43. (previously presented): A self-service terminal for allowing a user of the terminal to conduct an item dispensing transaction using spoken words, the terminal comprising:

means for creating at least one audible item dispensing prompt which contains within the prompt itself at least one word which is provided by the terminal and which can be spoken by the user to instruct the terminal to dispense an item to the user;

means for delivering the at least one audible prompt to the user;

means for receiving at least one word spoken by the user after the at least one audible prompt is delivered to the user;

means for determining if the at least one word received from the user corresponds to the at least one word provided by the terminal; and

means for dispensing an item to the user when the at least one word received from the user corresponds to the at least one word provided by the terminal.

44. (previously presented): A terminal according to claim 43, further comprising means for sensing that a user desires to use the terminal.

45. (previously presented): A terminal according to claim 44, wherein the sensing means comprises a proximity sensor.

46. (previously presented): A self-service terminal for allowing a user of the terminal to conduct an item dispensing transaction using spoken words, the terminal comprising:

means for creating at least one audible item dispensing prompt which contains within the prompt itself a question which can be answered by the user speaking either a positive response or a negative response to the question;

means for delivering the at least one audible prompt to the user;

means for receiving at least one word spoken by the user after the at least one audible prompt is delivered to the user;

means for determining if the at least one word received from the user answers the question contained within the at least one audible prompt delivered to the user; and

means for dispensing an item to the user when the at least one word received from the user answers the question by indicating that the user chooses to have an item dispensed.

47. (previously presented): A terminal according to claim 46, wherein the determining means includes means for determining if the at least one word received from the user is a positive response to the question.

48. (previously presented): An automated teller machine (ATM) for allowing a customer of the ATM to conduct a cash dispensing transaction using spoken words, the ATM comprising:

means for creating an audible cash dispensing prompt which contains within the prompt itself a cash dispensing word which is provided by the ATM and which can be spoken by the customer to instruct the ATM to dispense cash to the customer;

means for delivering the audible cash dispensing prompt to the customer;

means for receiving at least one word spoken by the customer after the audible cash dispensing prompt is delivered to the customer;

means for determining if the at least one word received from the customer corresponds to the cashing dispensing word provided by the ATM; and

means for dispensing cash to the customer when the at least one word received from the customer corresponds to the cash dispensing word provided by the ATM.

49. (previously presented): An ATM according to claim 48, further comprising:

means for creating an audible balance enquiry prompt which contains within the prompt itself a balance enquiry word which is provided by the ATM and which can be spoken

by the customer to instruct the ATM to provide the customer with a number representing the balance of the customer's account; and

means for providing the customer with a number representing the balance of the customer's account when the at least one word received from the customer corresponds to the balance enquiry word provided by the ATM.

50. (previously presented): A method of allowing a user of a self-service terminal to conduct an item dispensing transaction using spoken words, the method comprising:

creating at least one audible item dispensing prompt which contains within the prompt itself at least one word which is provided by the terminal and which can be spoken by the user to instruct the terminal to dispense an item to the user;

delivering the at least one audible prompt to the user;

receiving at least one word spoken by the user after the at least one audible prompt is delivered to the user;

determining if the at least one word received from the user corresponds to the at least one word provided by the terminal; and

dispensing an item to the user when the at least one word received from the user corresponds to the at least one word provided by the terminal.

51. (previously presented): A method of allowing a user of a self-service terminal to conduct an item dispensing transaction using spoken words, the method comprising:

creating at least one audible item dispensing prompt which contains within the prompt itself a question which can be answered by the user speaking either a positive response or a negative response to the question;

delivering the at least one audible prompt to the user;

receiving at least one word spoken by the user after the at least one audible prompt is delivered to the user;

determining if the at least one word received from the user answers the question contained within the at least one audible prompt delivered to the user; and

dispensing an item to the user when the at least one word received from the user answers the question by indicating that the user chooses to have an item dispensed.

52. (previously presented): A method of allowing a customer of an automated teller machine (ATM) to conduct a cash dispensing transaction using spoken words, the method comprising:

creating at least one audible cash dispensing prompt which contains within the prompt itself at least one word which is provided by the ATM and which can be spoken by the customer to instruct the ATM to dispense cash to the customer;

delivering the at least one audible prompt to the customer;

receiving at least one word spoken by the customer after the at least one audible prompt is delivered to the customer;

determining if the at least one word received from the customer corresponds to the at least one word provided by the ATM; and

dispensing cash to the customer when the at least one word received from the customer corresponds to the at least one word provided by the ATM.